

Appl. No. 10/071,376  
Amendment transmitted on February 2, 2004  
Reply to Office action of October 31, 2003

### REMARKS

Claims 1-16 are pending in the present application.

#### Objection to the Drawings

The Examiner objected to the drawings because they include the following reference numerals that are not mentioned in the specification: 39, 41, and 44. Applicants respectfully disagree with the Examiner's assertion that these reference numerals are not mentioned in the specification. Indeed, all of this reference numbers appear in the specification at page 11, lines 30-31 and page 12, lines 1-2.

#### Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 1, 2, and 10-16 under 35 U.S.C. §103 as being unpatentable over Edstrom, U.S. Patent No. 5,546,715 ("Edstrom") in view of the text of the Present Application at page 1, lines 26-29 ("Present Application, page 1"), in further view of the year 2000 web brochure for Buell Door ("Buell"). The Examiner argues that Edstrom teaches a laminated wood piece having a solid hardwood component (a veneer piece, 5d) and having an upper surface and a lower surface that are substantially parallel to each other and a wood composite component having layers oriented substantially parallel to the lower surface of the solid hardwood component. The Examiner concedes that Edstrom fails to disclose a core component that is made from layers of a wood composite material. However Present Application, page 1 teaches that "wood composite materials can be used to form the internal core of a door", in order to have use less wood and to have a cheaper more durable core. The Examiner also concedes that Edstrom fails to disclose the specific dimensions and proportions of the present invention, but applies the Buell reference to disclose thicknesses of the solid hardwood component that purportedly overlap the thickness ratios of the solid hardwood component to the wood composite component recited in present claims 1, 10, and 14.

Applicants respectfully disagree with this analysis and traverse this rejection as follows.

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*The Examiner's Assertion that Applicant's Previous Arguments are Moot*

In the Office Action of October 31, 2003 the Examiner dismisses the arguments that Appellants presented in the Amendment mailed on July 21, 2003 as moot in view of the new grounds of rejection contained in October 31 Office Action. Applicants respectfully assert that the Examiner is incorrect, and the arguments presented in the July 21 amendment are not moot.

The Office Action of October 31 does not really contain any new grounds of rejection. The content of the Examiner's argument that the present claims are obvious in view of the Edstrom, Buell and the Present Application, page 1 as set forth in the October 31, 2003 Office Action is almost identical to the corresponding obviousness argument that the Examiner first set forth in the Office Action of March 19, 2003. In fact the text of the argument set forth in the March 19 Office Action is repeated virtually verbatim in the October 31 Office Action, with the exception that the Examiner has now added a small amount of additional text from the present specification as prior art.

Thus, given that the Examiner has simply repeated the bulk of her previous arguments, the traversal that Applicants previously presented in the amendment filed on July 21, 2003 are also application to the rejections in the October 31 Office Action. Accordingly, Applicants direct the Examiner's attention to pages 6-11 of the July 21 Amendment, where this traversal is set forth in detail. The Applicants will now summarize this transversal and then respond to the additional prior art reference newly applied by the Examiner in the October 31, 2003 Office Action.

The teachings of Edstrom and Buell are summarized on page 5 in the amendment filed on July 21, 2003. As for the additional prior art reference cited in the October 31, 2003 Office Action (Present Application, page 1), this prior art reference discloses that wood composite materials can be used to form the internal "core" of the door.

In order to establish a prima facie case of obviousness, the Examiner must make all of the following showings: (1) there must be some suggest or motivation to modify or combine the reference(s) as suggested by the Examiner (it is not sufficient to say that the cited reference(s) can be modified or combined without a teaching in the prior art to suggest the

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desirability of the combination or modification); (2) there must also be a reasonable expectation of success for the modification or combination; and (3) the reference(s), taken either alone or in combination, must teach or suggest all elements of the present claims. (M.P.E.P. §2143).

For the following reasons the present claims are not obvious in view of Edstrom, Buell, and Present Application, page 1.

First, Edstrom does not teach the use of a wood composite material nor does Edstrom mention the presence of layers of wood composite material. Edstrom mentions the term "composite" only once, (Col. 4, lines 30-34), and in that instance composite is meant to describe a door jamb that is constructed from attaching several different pieces together. Edstrom does not characterize the wood material itself as a composite material. (For this argument in detail, see Amendment filed July 21, 2003, pages 7-8).

Second, Edstrom also fails to disclose a wood material present in the form of multiple layers as recited in the present claims. (For this argument in detail, see Amendment filed July 21, 2003, page 8).

Third, rather than teaching the layered, wood composite material set forth in the present claims, Edstrom explicitly teaches the use of wood materials quite different from the wood composite material recited in the present claims. Edstrom discloses the use of solid wood lumber rather than composite wood material. (See Amendment filed July 21, 2003, page 8).

Fourth, regarding Buell. This reference fails to teach any sort of wood composite material, and the Examiner has not asserted that Buell teaches the presence of a wood composite material, nor the presence of multiple layered wood material. Further the Examiner has not identified any teaching or suggestion that would have motivated a person of ordinary skill to modify the jamb disclosed in the Edstrom reference by using the stile and door frame proportions disclosed in Buell. In order to combine two prior art references, the Examiner must identify a teaching in the prior art that would suggest the desirability of the combination. The Examiner has failed to identify any teaching in the prior art itself that would suggest such a combination, but instead suggests, on her own initiative, that a person of ordinary skill would have been motivated by the teachings of the Buell Brochure to have built the device of Edstrom within the dimensions described by Buell in order to reduce material costs. This proposed motivation is

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flawed for several reasons, most notably that Buell simply lacks any disclosure that would have suggested combining Buell and Edstrom in the manner suggested by the Examiner. (See Amendment filed July 21, 2003, pages 9-10).

The Examiner now also cites Present Application, page 1 as part of the obviousness rejection. Specifically, the Examiner concedes that Edstrom fails to disclose a core component that is made from layers of a wood composite material, but notes the disclosure set forth in the specification on page 1, lines 26-29, which teaches that “‘wood composite materials can be used to form the internal core of a door’, in order to use less wood and to have a cheaper more durable core.” The Examiner then concludes that, “it would have been obvious that the core referred to by Edstrom could be fashioned from a wood composite material, in order to have a more durable and cheaper core.” (Office Action of October 31, 2003, Page 3).

The Applicants respectfully disagree with the Examiner's conclusion because there is no teaching or suggestion that would have motivated a person of ordinary skill in the art to combine the teachings of Present Application, page 1 with Edstrom. The term “core” as used by Edstrom and “core” as used in the Present Application, page 1 are two entirely different construction elements. Edstrom uses the word “core” to indicate a portion of a wood door frame jamb. (Col. 2, lines 42-65; *see also* Figures 2-4, element 6a is the “core”). By contrast, in Present Application, page 1 the “core” is a component of the door itself. Thus, the Examiner is swapping the part of a door frame for part of a door. The cited motivations for making such a modification, because it would make a more durable and less expensive core are irrelevant, in view of the fact that Edstrom is discussing a door frame and Present Application, page 1 is discussing the door itself.

Indeed, there is nothing in the prior art that would have suggested to a person of ordinary skill to combine the references in the manner suggested by the Examiner. While the Examiner is of course allowed to use the Applicants' admissions as prior art, the Examiner may not use the inventive teachings which the Applicant has disclosed for the first time, to reconstruct in hindsight the Applicant's claimed invention. That is what the Examiner has done. There is nothing in Edstrom that would have suggested replacing a wood composite piece for the solid lumber material designated as the “core”. Similarly, the prior art admission at Present

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Application, page 1 is confined entirely to discussing wood composite materials for door frames. Combining Edstrom and Present Application, page 1 would suggest itself only after using the text of the Present Application itself as a template for reconstructing the invention. Such hindsight reconstruction is, of course, impermissible.

Therefore, based on the above remarks, the Examiner has failed to establish that claims 1, 2, and 10-16 are obvious in view of Edstrom, Present Application, page 1, and Buell. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

The Examiner has rejected claims 3-9 under 35 U.S.C. §103 as being unpatentable over Edstrom, Buell, the disclosure of Figure 5 in the Present Application ("Present Application, Figure 5") and U.S. Patent Application 2003/0008110 A1 to Hsu ("Hsu"). The Examiner applies Edstrom, and Buell as described above and specifically including a laminated wood piece having a width of between 3 cm to 6 cm, and a length of between 120 cm and 305 cm—the subject matter recited in claim 4. The Examiner concedes that Edstrom, Present Application, Figure 5, and Buell do not specifically recite a material made from oriented strand board, nor do they recite the specific subject matter such as the screw holding strength, the material density, and the split resistance of greater than about 1000 lbs., which are recited in claims 5, 7, and 8.

On page 5 of the Office Action, the Examiner asserts that the elements recited in claim 5, 7, and 8 are disclosed in Hsu. Specifically, the Examiner writes, "Hsu teaches oriented strand board with a screw holding strength of about 400 lbs to about 1200 lbs...[and], a split resistance of greater than about 1000 lbs., where at least 90 wt% of the strands are oriented substantially parallel to the length of the laminated wood piece ..."

(It should be noted that the Examiner does not explain the relevance of Present Application, Figure 5. Without any further explanation, the Examiner does mention that "the prior art" is applied as cited above. This is incomplete. In the first obviousness rejection the Examiner did explain the relevance of the prior art disclosed at Present Application, page 1, but the Examiner has not cited that portion of the specification in the present obviousness rejection, and so it is not relevant here. Nowhere does the Examiner explain how the Present Application, Figure 5 is relevant to the patentability of the present invention.)

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Claims 3-9 are believed to be allowable, because these claims are dependent on claim 1, which Applicants believe to be in allowable form for the reasons discussed above. Further, Applicants respectfully disagree with the Examiner's analysis as set forth in the present rejection based on Edstrom, Buell, Present Application, Figure 5, and Hsu and traverse this rejection as follows.

This rejection is virtually identical to the corresponding obviousness rejection based on Edstrom, Buell, and Hsu that was set forth in the Office Action of March 19, 2003. The Examiner has now also added an additional reference: the admitted prior art disclosed in Figure 5 of the Present Application, although the Examiner has provided no explanation as the relevance of this prior art. Despite the near identity between the grounds for the obviousness rejection contained in the recent October 31 Office Action and those stated in the March 19 Office Action, the Examiner has disregarded the Applicants' arguments presented in their July 21 Amendment in response to the March 19 Office Action as "moot".

The Examiner's disregard for the arguments previously presented by Applicants is particularly puzzling in view of the Examiner's continued reliance on Hsu for teaching the subject matter of claims 5, 7, and 8. In the Office Action of March 19, 2003 (and repeated verbatim in the Office Action of October 31, 2003, the Examiner wrote: "Hsu teaches oriented strand board with a screw holding strength of about 400 lbs to about 1200 lbs...[and], a split resistance of greater than about 1000 lbs., where at least 90 wt% of the strands are oriented substantially parallel to the length of the laminated wood piece ..."

In the Amendment filed on July 21, 2003 the Applicants noted that Hsu did not only fail to teach these values for the parameters of screw holding strength, split resistance and the degree of parallel alignment, Hsu failed to even mention the parameters themselves. (See Amendment, July 21, 2003, page 12).

Applicants again request that if the Examiner insists on maintaining this rejection, the Examiner cite with greater specificity where the Hsu reference mentions the screw holding strength as recited in claim 5 and specification paragraph 0051, the split resistance recited in claim 7 and paragraph 0048, and the strand orientation recited in claim 8.

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Additionally, as Applicants have previously argued (see Amendment, July 21, 2003, page 12) the Examiner has not identified any teaching or suggestion that would have motivated a person of ordinary skill to combine Edstrom, Buell and Hsu. In fact, the Examiner has offered no explanation as to why it would be obvious to combine these three references. Hsu teaches multi-layer lignocellulosic boards. Neither Edstrom nor the Buell references explicitly disclose such a material as far as the Examiner has shown. Even if Edstrom and/or Buell did disclose such a material, the Examiner would still be under the obligation of showing why it would be obvious to combine these references. Nor does the Examiner explain why it would be obvious to combine yet a fourth prior art reference, Present Application, Figure 5, newly applied in the Office Action of October 31, 2003, with the previously applied three prior art references.

Accordingly if the Examiner wishes to maintain this rejection, Applicants respectfully request that the Examiner specifically identify the teaching or suggestion that would have motivated a person of ordinary skill in the art to combine Present Application, Figure 5 with: (1) Hsu, (2) Edstrom, and (3) Buell references.

Therefore, based on the above remarks, the Examiner has failed to establish that claims 3-9 are obvious in view of Hsu, Edstrom, Buell, and Present Application, Figure 5. Reconsideration and withdrawal of the rejections of claims 3-9 are respectfully requested.

#### CONCLUSION

Reconsideration and withdrawal of the rejection of the claims in view of the remarks provided herein and allowance of the claims being prosecuted are respectfully requested.

Respectfully submitted,

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